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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,455	12/26/2001	Takayoshi Oyamada	0649-0814P	2939

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EXAMINER

CHEA, THORL

ART UNIT PAPER NUMBER

1752

DATE MAILED: 07/02/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/025,455

Applicant(s)

OYAMADA ET AL.

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-13 are rejected under 35 U.S.C. 103(a) as obvious over the combination of EP1004930 (EP'930) and Matsumoto et al (Matsumoto). The EP'930 discloses a photothermographic material containing non-photosensitive organic silver salt grain similar to that of the claimed invention. The grain having aspect ratio (AR) of at least 3; the average of the average grain diameter of 0.01 to 0.8  $\mu\text{m}$ ; the average of the needle ratio of said grain measure from the principal plane direction (Needle ratio =  $(M \times L) / (N \times G)$ ) is not less than 1.1 and less than 10 (page 3, and page 4). On page 5, paragraph [0052 to 0053], the silver behenate, silver arachidate, and/or silver stearate are preferred organic silver salt. Matsumoto in column 17 lines 10-15 discloses "silver behenate is the most preferred in terms of whiteness and light stability. Silver behenate also has excellent moisture resistance, and can be used in combination with a reducing agent having a relatively weak reducing ability".

It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to would have selected silver behenate having grains structure within the scope taught in EP'930 to provide the non-photosensitive organic silver salt

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grains claimed in the present claimed invention. The worker of ordinary skill in the art would have selected the silver behenate because of its excellent moisture resistance and the its having a relatively weak reducing ability recognized in Matsumoto and the non-photosensitive organic silver salt having grains structure taught in EP'930 provides photothermographic material with high sensitivity, reduced image defects as well as low fog.

The limitation of claims 6-8 are related to the claiming of a material by a process. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process." In re Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985).

3. Claims 1-13 are rejected under 35 U.S.C. 103(a) as obvious over the combination of EP0962812 (EP'812) and Matsumoto et al (Matsumoto).

EP'812 discloses a heat-developable material containing having fatty acid silver salt particle having the average equivalent-sphere diameter from 0.1 to 0.8  $\mu\text{m}$ ; the average ratio of long sides/short sides in main planes of 1 to 4; the aspect ratio of 2 to 30. The preferred aliphatic carboxylic acids include cerotic acid, lignoceric acid, behenic acid, erucic acid, arachidic acid, stearic acid, ...camphoric acid and mixture thereof. See page 5, paragraph [0035]. The preparation of silver behenate is shown on page 25-26, especially Table 2. The material having one or more layer is shown on page 21,

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paragraph [0187]. Matsumoto in column 17 lines 10-15 discloses that "silver behenate is the most preferred in terms of whiteness and light stability. Silver behenate also has excellent moisture resistance, and can be used in combination with a reducing agent having a relatively weak reducing ability". It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to would have selected silver behenate having grains structure within the scope taught in EP'930 to provide the non-photosensitive organic silver salt grains claimed in the present claimed invention. The worker of ordinary skill in the art would have selected the silver behenate because of because of its excellent moisture resistance and the its having a relatively weak reducing ability recognized in Matsumoto and the non-photosensitive organic silver salt having grains structure taught in EP'930 provides photothermographic material with high sensitivity, reduced image defects as well as low fog.

The limitation of claims 6-8 is related to the claiming of a material by a process. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process." In re Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985).

***Response to Arguments***

4. Applicant's arguments filed April 11, 2003 have been fully considered but they are not persuasive. The silver behenate has been known in the art as having excellent moisture resistance and the its having a relatively weak reducing ability such as recognized in Matsumoto, and the worker of ordinary skill in the art would have select the silver behenate among the to form a non-photosensitive organic silver salt taught having structure taught in EP'930 or EP'812 since the non-photosensitive organic silver salt having grains structure taught in EP'930 or EP'812 provides photothermographic material with high sensitivity, reduced image defects as well as low fog. Accordingly, the invention as claimed would have been found prima facie obvious over the applied prior art of record. The combination of fatty acid silver salt such as silver arachidate in combination with silver behenate in claim 13 would have been found prima facie obvious to the worker of ordinary skill in the art. It is prima facie obvious to combine two compositions each of which taught by the prior art to be useful for the same purpose in order to form a third composition to be used for the same purpose. In re Kerhoven, 205 USPQ 1069, 1072 (CCPA 1980).

***Conclusion***


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

Tchea   
June 23, 2003



Thorl Chea  
Primary Examiner  
Art Unit 1752